

REMARKS

I. Status of the Claims

Claims 25-29 are pending in the application. Claims 25 is objected to. Claims 25 and 28 stand rejected under 35 U.S.C. §102(b) over Pirola *et al.*, claim 25 is rejected under §102(b) over Topping *et al.*, claims 25, 26 and 28 stand rejected under §102(b) over Deftos *et al.*, claims 25, 26 and 28 stand rejected under §102(b) over Allinson & Drucker, claim 25 is rejected under §102(b) over Yamaguchi, and claims 25 and 26 stand rejected over Rabbani *et al.* The specific grounds for objection/rejection, and applicants' response thereto, are set out in detail below.

At the outset, applicants note that the Office Action provides no basis for rejection of claims 27 or 29. However, these claims are indicated as rejected on the first page of the action. Clarification of the status of these claims *via teleconference* is respectfully requested upon the examiner's receipt of this response.

Amendment of claim 25 is offered. Support for the amendment can be found at page 11, lines 9-11. New claims 30 and 31 are offered. Support for claim 30 can be found at page 22, lines 22-23. Support for claim 31 can be found at page 23, lines 24-27. Thus, no new matter is offered by these amendments.

II. Objection to Drawings and Claim 25

The examiner has noted that FIG. 4, which is said to illustrate dexamethasone, is incorrect. Applicants are providing a replacement figure with the correct chemical illustration.

Claim 25 is objected to for initial use of the acronym "PTH-rP." An amendment is provided inserting the full name of the molecule. Reconsideration and withdrawal of the objection is respectfully requested.

III. Rejection Under 35 U.S.C. §112, Second Paragraph

Claims 25-29 stand rejected under the second paragraph of §112. The examiner states that the active steps of claim 25 do not comport with the purpose stated in the preamble. Applicants traverse, but in the interest of advancing the prosecution, an amendment of the claim. Reconsideration and withdrawal of the rejection is, therefore, respectfully requested.

IV. Rejections Under 35 U.S.C. §102

Claims 25, 26 and 28 stand rejected under §102 over a variety of references showing compounds that allegedly alter PTH-rP production in cells. Applicants traverse.

Claim 25 has been amended to recite *in vivo* reduction of PTH-rP production, and hence reduction of bone destruction, in a cancer patient. None of the references teaches this embodiment, nor does any reference suggest that this would be a useful endeavor.

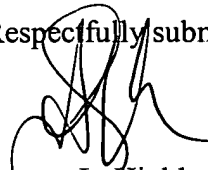
In light of the foregoing, applicants respectfully request reconsideration and withdrawal of the rejection.

V. **Conclusion**

In light of the foregoing, applicants respectfully submit that all claim are in condition for allowance, and an early notification to that effect is earnestly solicited. The examiner is invited to contact the undersigned at the telephone number listed below with any questions, comments or suggestions relating to the referenced patent application.

Please date stamp and return the enclosed postcard as evidence of receipt.

Respectfully submitted,



Steven L. Highlander
Reg. No. 37,642
Attorney for Applicants

FULBRIGHT & JAWORSKI L.L.P.
600 Congress Avenue, Suite 2400
Austin, Texas 78701
(512) 536-3184

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APPENDIX A: MARKED UP COPY OF AMENDED CLAIMS

25. (Amended) A method of [regulating (PTH-rP) production in mammalian cells] decreasing bone destruction in a cancer patient comprising [the steps of:
- (i) identifying a compound that alters PTH-rP activity; and
 - (ii) contacting said cell with said] administering to said patient a compound that down-regulates parathyroid hormone-related peptide (PTH-rP) production through inhibition of the PTH-rP promoter, thereby decreasing bone destruction.
26. (Canceled) The method of claim 25, wherein said compound inhibits production of PTH-rP in mammalian cells.
27. (Amended) The method of claim [26] 25, wherein said compound is OSW3 or OSW6.
28. (Canceled) The method of claim 25, wherein said compound stimulates production of PTH-rP in mammalian cells.
29. (Canceled) The method of claim 28, wherein said compound is OSWs1.
30. (New) The method of claim 25, wherein the administration is repeated.
31. (New) The method of claim 25, wherein the administration is orally or intravenously.

APPENDIX B: CLEAN COPY OF PENDING CLAIMS (UNOFFICIAL)

25. A method of decreasing bone destruction in a cancer patient comprising administering to said patient a compound that down-regulates parathyroid hormone-related peptide (PTH-rP) production through inhibition of the PTH-rP promoter, thereby decreasing bone destruction.
27. The method of claim 25, wherein said compound is OSW3 or OSW6.
30. The method of claim 25, wherein the administration is repeated.
31. The method of claim 25, wherein the administration is orally or intravenously.